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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/802,867	03/18/2004	Marcos C. Tzannes	T3653-8848US02	5452
181	7590	05/10/2005	EXAMINER	
MILES & STOCKBRIDGE PC 1751 PINNACLE DRIVE SUITE 500 MCLEAN, VA 22102-3833			TSE, YOUNG TOI	
			ART UNIT	PAPER NUMBER
			2637	

DATE MAILED: 05/10/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No. 10/802,867	Applicant(s) <span style="float: right;">✓</span> TZANNES ET AL.	
	Examiner YOUNG T. TSE	Art Unit 2637	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 18 March 2004.
- 2a) ☐ This action is FINAL.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above claim(s) 13 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 18 March 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>03182004</u> . | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### *Election/Restrictions*

1. Applicant's election of Group I (claims 1-12) in the reply filed on February 14, 2005 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).
2. Claim 13 is withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on February 14, 2005.

### *Specification*

3. The disclosure is objected to because of the following informalities: Applicants are requested to insert a statement in the beginning of the specification to state that this application is a division of serial number 10/106,329, now U.S. Patent No. 6,731,695; in paragraph [0020], line 1, "Fig. 7 is flowchart" should be "Fig. 7 is a flowchart".  
Appropriate correction is required.

### *Claim Objections*

4. Claims 1-12 are objected to because of the following informalities: in 4 of claims 1, 4 and 7 and line 5 of claim 10, the phrase "a Q-mode" should be "the Q-mode" for

clarity. Wherein the dependent claims 2-3, 5-6, 8-9 and 11-12 are depended upon the independents claims 1, 4, 7 and 10, respectively. Appropriate correction is required.

5. Claims 2-3, 5-6, 8-9 and 11-12 are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. The claimed subject matter of claims 2-3, 5-6, 8-9 and 11-12 does not have the connection or cooperation of independent claims 1, 4, 7 and 10, respectively.

### ***Claim Rejections - 35 USC § 112***

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claims 1-12 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claims 1 and 4, the steps of receiving, transmitting and entering lack cooperation with each other.

In claim 7, the receiving means, the transmitting means and the entering means lack connection or cooperation with each other.

In claim 10, the receiving information, the transmitting information and the entering information lack connection or cooperation with each other.

Wherein the dependent claims 2-3, 5-6, 8-9 and 11-12 are depended upon the independents claims 1, 4, 7 and 10, respectively.

***Claim Rejections - 35 USC § 102***

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

9. Claims 1, 4, 7 and 10 are rejected under 35 U.S.C. 102(a) as being anticipated by Clearwater, ITU - Telecommunication Standardization Sector, title "G.gen: G.dmt.bis: G.lite.bis: Proposal for Q-Mode" (cited by Applicants).

The article teaches a method and apparatus for a transmitter to enter a Q-mode general requires: 1. The transmit TPS-TC shall generate an all zero bearer channel if no user data are available for transmission at the V reference point; 2. The transmit PMS-TC shall generate an all zero overhead channel if no overhead data are available for transmission; 3. The PMS-TC shall pass all zero symbol data to the PMD when no user data at the V reference point and no overhead information are available for transmission; 4. The transmit PMD may replace an all zero data symbol by a Q-mode symbol; and 5. The reverse operations at the receiver shall not require any Q-mode specific information to be communicated from the transmitter.

With respect to claims 1, 4, 7 and 10, the proposal for a method or apparatus of a transmitter to enter a Q-mode is capable of receiving an all zeros bit pattern,

transmitting a Q-mode symbol, and entering the Q-mode wherein the entry and exit of the Q-mode is independent of an operational state of a receiver.

### ***Double Patenting***

10. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

11. Claims 1, 4, 7 and 10 are rejected under the judicially created doctrine of double patenting over claims 4-7 of U. S. Patent No. 6,731,695 since the claims, if allowed, would improperly extend the "right to exclude" already granted in the patent.

The subject matter claimed in the instant application is fully disclosed in the patent and is covered by the patent since the patent and the application are claiming common subject matter, as follows: although claims 1, 4 7 and 10 of the instant application do not include all the claimed subject matter of claims 4-7 of U. S. Patent No. 6,731,695, the claimed subject matter of receiving an all zeros bit pattern, transmitting a Q-mode symbol, and entering the Q-mode wherein the entry and exit of the Q-mode is independent of an operational state of a receiver is recited in claims 4-7 of U. S. Patent

No. 6,731,695. Therefore, they are not patentably distinct from each other because the broader claims of the instant application would have been obvious in view of the narrow issued claims of the U. S. Patent No. 6,226,323 (see *In re Emert*, 124 F.3d 1458, 44USPQ2d 1149).

Furthermore, there is no apparent reason why applicant was prevented from presenting claims corresponding to those of the instant application during prosecution of the application which matured into a patent. See *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP § 804.

### ***Conclusion***

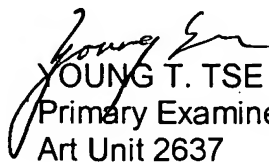
12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Tellado et al. discloses a system for reducing the peak to average power ratio of a multi-carrier signal to ensure that amplifiers and transmitters are not saturated, causing loss of data.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to YOUNG T. TSE whose telephone number is (571) 272-3051. The examiner can normally be reached on Monday and Wednesday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jay Patel can be reached on (571) 272-2988. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
YOUNG T. TSE  
Primary Examiner  
Art Unit 2637